

Docket No. 3350-31B
File No. 1158.41324CC2
Client No. BillPayB



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PATENT
3624
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

KIGHT et al

Serial No. 09/250,711

Filed: February 16, 1999

For: SYSTEM AND METHOD FOR ELECTRONICALLY PROVIDING CUSTOMER
SERVICES INCLUDING PAYMENT OF BILLS, FINANCIAL ANALYSIS AND
LOANS

:
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: Group Art Unit: 3624
: Examiner: J. Bergin
:

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GROUP 3600

REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

April 12, 2004

Sir:

This Reply Brief is submitted (in triplicate), further to the Supplemental Appeal Brief filed on August 22, 2003 and Appeal Brief filed on March 7, 2003, and in reply to the Examiner's Answer issued on February 11, 2004.

The Examiner's withdrawal of the rejection of claims 44 and 54 under 35 USC §112, second paragraph, is acknowledged.

The Examiner asserts that all of the rejected claims (i.e., claims 1, 4-5, 21, 25, 34-35, 39-40, 44-50, 49-50, 54 and 56) stand and fall together. In this regard, the Examiner contends that the Supplemental Appeal Brief submitted on August 22, 2003 does not include a statement that the claims does not stand and fall together and reasons in support thereof.

However, contrary to the Examiner's assertion, the groupings of the claims is set forth on page 8 of the Supplemental Appeal Brief submitted on August 22, 2003. As set forth therein, and supported in the arguments presented in Section X of the Supplemental Appeal Brief on pages 8-28, the claims do not stand and fall together.

Rather, claims 1, 4-5, 34 and 40 stand and fall together; claims 21, 39 and 44 stand and fall together; claims 25, 49-50 and 54 stand and fall together; claim 35 stands and falls alone; claims 45 stands and falls alone; and claim 56 stands and falls alone.

In paragraph (10) entitled "Grounds of Rejection", the Examiner states that "The following ground(s) of rejection are applicable to the appealed claims: claims 1, 4-5, 21, 25, 34-35, 39-40, 44-45, 49-50, 54, and 56 rejected under 35 USC §103. This rejection is set forth in prior Office Action, Paper No. 30.

Accordingly, the Examiner withdrawal of the rejection under 35 USC §112, first paragraph is also acknowledged. Hence, the lengthy dissertation of case law relating to the written description requirement under 35 USC §112, first paragraph, is superfluous. In any event, the Examiner fails to provide any rebuttal to the traversal arguments presented in the Supplemental Appeal Brief relating to the prior rejection of claims under 35 USC §112, first paragraph (see, for example, the traversal arguments presented on pages 10-14 of the Supplemental Appeal Brief).

Regarding the traversal of the obviousness rejection under 35 USC §103(a), the Examiner responds by asserting "Benton, et al. is being applied only to show evidence of the ubiquitously well known nature of ACH and ATM methods of electronic funds transfer at the time that the invention was made. Lawlor, et al. is not being modified by the specific Ach debiting of Benton, et al. but by the ubiquitously well know ACH method of funds transfer as disclosed in Benton, et al. (emphasis in original)

However, the Examiner's assertion does not address how Lawlor, et al. can be modified to perform ACH debiting when such a modification would be inconsistent with Lawlor's own teachings, and result in a system which is incapable of meeting Lawlor's stated objectives. Indeed, the proposed modification to Lawlor, et al. would change a

principle of operation of Lawlor, et al. As noted In re Ratti, 123 USPQ 349 (CCPA 1959), in such a case, the teachings of the applied art are insufficient to render the claims prima facie obvious.

In the final paragraph on page 7, the Examiner asserts that "With regards to Applicant's argument that there is no reasonable expectation of success, one of ordinary skill in the art would know that ACH transfer would be used to debit the account in connection with the electronic payments".

The Examiner's contention is not understood. For example, although the Examiner asserts that one of ordinary skill in the art would know that ACH transfer could be used to debit the account in connection with via electronic payments, Lawlor, et al. explicitly teaches against such debiting. Furthermore, Lawlor, et al. expressly teaches the use of a specialized network device which emulates an ATM. Accordingly, it is unclear how such a device could be modified to perform ACH debiting, even if this could somehow be done without violating a principle of operation of Lawlor, et al.

Accordingly, it is again respectfully submitted that the Examiner has failed to establish a prima facie basis for the rejection, ignored or misconstrued that which is disclosed and claimed in the present application and the prior art, has proposed to modify the applied prior art in a manner which is unmotivated, has failed to apply art which either teaches or suggests the claimed invention, and has either improperly attempted to reconstruct the invention based upon the present application disclosure or relied on pure speculation in rejecting the claims.

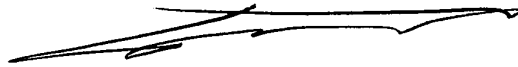
Accordingly, the rejection of the pending claims is in error, and reversal is clearly in order and is courteously solicited.

To the extent necessary, Applicants petition for an extension of time under 37

CFR § 1.136. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to the Deposit Account No. 01-2135 (Case No. 1158.41324CC2) and please credit any excess fees to such Deposit Account.

Respectfully submitted,

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File No. 1158.41324CC2
Client Ref: BillPayB



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Kight et al. : Group Art Unit: 3624
Serial No.: 09/250,711 :
Examiner: J. Bergin
Filed: February 16, 1999 :

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For: SYSTEM AND METHOD FOR ELECTRONICALLY PROVIDING CUSTOMER SERVICES INCLUDING PAYMENT OF BILLS, FINANCIAL ANALYSIS AND LOANS

TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

April 12, 2004

Sir:

Transmitted herewith is a Reply Brief in the above-identified application.

- [] No additional fee is required.
[X] Also attached: Request for Oral Hearing and Credit Card Payment Form

Fee has been calculated as shown below:

	NO. OF CLAIMS	HIGHEST PREVIOUSLY PAID FOR	EXTRA CLAIMS	RATE	FEE
Total Claims	17	33	0	x \$18 =	\$0
Independent Claims	5	18	0	x \$84 =	\$0
Fee for Request for Oral Hearing					\$290.00
TOTAL FEE DUE					\$290.00

- [X] A Credit Card Payment Form in the amount of \$290.00 is attached
- [X] Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 01-2135, including any filing fees under 37 CFR 1.16 for presentation of extra claims and any patent application processing fees under 37 CFR 1.17.

Respectfully submitted,

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Docket No. 3350-0031B
File No. 1158.41324CC2
Client No. BillPayB



PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of

KIGHT et al

Serial No. 09/250,711

Filed: February 16, 1999

For: SYSTEM AND METHOD FOR ELECTRONICALLY PROVIDING CUSTOMER
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GROUP 3600

REQUEST FOR ORAL HEARING

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

April 12, 2004

Sir:

An Oral Hearing before the Board of Patent Appeals and Interferences, pursuant to 35 C.F.R. 1.194 is hereby requested by the undersigned in the Appeal taken in the above-captioned utility application. A Credit Card Payment Form for the Hearing fee, in the amount of \$290.00 is enclosed.

The Commissioner is hereby authorized to charge any additional fees associated with this communication or credit any overpayment, to Deposit Account No. 01-2135, including any patent application processing fees under 37 CFR 1.17.

Respectfully Submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP

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